

**REMARKS****Status of the Claims**

Upon entry of the amendment above, claims 1-20, 24-27, and 29-32 will be pending, claims 1, 2, 13, 14, and 24 being independent. Claims 1-18, 24-27, 29, 32 are "readable" on the elected invention.

In addition, claim 15, withdrawn from consideration by the Examiner as allegedly not being directed to the elected invention, is directed to the elected invention.

**Summary of the Office Action**

In Section 2 of the Office action (page 2), dependent claims 15, 19, and 20 remain withdrawn from consideration as being directed to a non-elected invention, pursuant to the Examiner's previous restriction requirement. Applicant had elected the invention shown, e.g., in Figs. 6 and 7.

In Section 3 of the Office action (page 2), the Examiner objects to claim 2 because of the occurrence of "the the" in line 7.

In Section 5 of the Office action (beginning on page 2), the Examiner rejects all of the claims, except for claim 2, under 35 USC 112, second paragraph, as allegedly being indefinite.

Claims 1, 3-14, 18, 24-27, 29, and 30 are rejected under 35 USC 103(a) as being unpatentable over REINHART et al. (U.S. Patent No. 2,261,453, hereinafter "REINHART") in view of BOURDEAU (U.S. Patent No. 5,887,886), as mentioned in Section 8, beginning on page 3 of the Office action.

Claims 1-14, 16-18, 24-27, 29, and 30 are rejected under 35 USC 103(a) as being unpatentable over HOSHIZAKI et al. (U.S. Patent No. 5,498,033) in view of BOURDEAU, as mentioned in Section 9, beginning on page 4 of the Office action.

**Response to the Office Action****A. Withdrawal of Objection**

In response to the objection to claim 2, Applicant has amended the claim to remove the double recitation of "the." Accordingly, reconsideration and withdrawal of the objection is requested.

**B. Withdrawal of Rejection Under 35 USC 112, Second Paragraph**

As mentioned above, all but claim 2 are rejected under 35 USC 112, second paragraph, for alleged indefiniteness. This rejection is directed to the following expressions which describe the uppermost extent of the external upper of the boot of the invention: "at about mid-height of a tibia area of the boot" (claim 1) and "about a middle region of a tibia of the user" (claims 13, and 14).

Neither of these expressions appear in claims 24-27 and, therefore, reconsideration and withdrawal of the rejections of these claims is requested.

Regarding the remaining claims, the Examiner takes the position that "it is not clear what structure such language would encompass." Regarding claims 13 and 14, the Examiner even states that the expression is "inaccurate."

Applicant does not understand why the Examiner finds the noted expressions to be inaccurate.

First, the expressions had been previously recited in claims 21-23 and those claims had not been rejected.

Second, the expressions literally appear in the specification.

Further, Applicant respectfully submits that the Examiner is mistaken that the claims are indefinite on the basis that "this height" will vary from one user to the next. That is, although the height of the middle of one's tibia is variable relative to the height of others, the middle region of any particular tibia is reasonably determinable. Consequently, regarding the invention, the size of the boot would also vary according to the user. That is, regardless of the length of one's tibia, its middle can be said to be reasonably determinate.

At least for the foregoing reasons, reconsideration and withdrawal of the rejection is requested.

**C. Withdrawal of Rejection Under 35 USC 103(a) Based Upon REINHART and BOURDEAU**

As mentioned above, claims 1, 3-14, 18, 24-27, 29, and 30 are rejected under 35 USC 103(a) as being unpatentable over REINHART in view of BOURDEAU.

Applicant requests that the rejection be withdrawn at least for the reasons of record and those that follow.

Based upon the Examiner's initial comments regarding BOURDEAU (see the sentence bridging pages 3 and 4 of the Office action), BOURDEAU is initialled relied upon for its disclosure of a high boot. The Examiner admits that REINHART does not appear to show a dorsal portion extending to mid-height of a tibia area of the boot. Regarding this issue (which is relevant to independent claims 1, 13, and 14, which are also rejected for indefiniteness, as mentioned above, regarding the same subject matter), the Examiner takes the position that it would have been obvious to have made the dorsal part of the shoe of REINHART higher, as suggested by BOURDEAU.

In addition, there appears to be a second reason for the Examiner's reliance upon BOURDEAU, although it is not particularly clear. In dependent claim 4 and in independent claim 24, it is specified that the lateral arm (claim 4) or lateral portion (claim 24) of the flexible frame extends to the metatarsophalangeal joint of the foot. In claim 24, it is more specifically described that the lateral portion extends to the metatarsophalangeal joint from an area spaced above the sole.

The Examiner cites the so-called "wide scallop 44" of BOURDEAU and concludes that it would have been obvious to have modified the dorsal portion of the REINHART shoe to have a wide scallop like that of BOURDEAU.

Applicant respectfully submits that the only reason for the Examiner's statement is the above-mentioned subject matter in claims 4 and 24.

However, Applicant submits that there would have been no reason to have modified the REINHART shoe by means of any teaching in BOURDEAU other than for the purpose of rejecting Applicant's claims.

First of all, REINHART pertains to the field of general shoes, shoes which cover the ankles. BOURDEAU pertains to specialized boots, viz., those used in skiing or snowboarding. One skilled in the art would not consider a modification as proposed in the rejection.

If, however, one were to consider a modification of REINHART's shoe by means of

BOURDEAU's disclosure, Applicant also would submit that Applicant's invention would not result.

The goal of REINHART is to prevent a portion of the upper of the shoe from wrinkling, crunching, or assuming such a shape or form that the user's foot is liable to assume an improper position in the shoe (see column 1, lines 28-36).

BOURDEAU, on the other hand, is directed to a sport boot having a sole and an attachment member (see elements 31, 32) affixed to the sole against movement with respect to the sole. The boot comprises an upper having a rigid internal skeleton extending from a portion of the sole and upwardly at least along a lateral side of the boot (see, e.g., claim 4, or column 2, lines 14-41). The skeleton constitutes a minimal energy circuit for the transmission of forces and support, such circuit passing through the attachment means of the boot.

Of course, for the boot of the invention, with no attachment means like that of BOURDEAU, there would have been no need to use the skeleton of BOURDEAU. And with no skeleton, there would be no suggestion to one skilled in the art to make the dorsal part of the shoe of REINHART higher in view of BOURDEAU.

Regarding the wide scallop 44 of BOURDEAU, the same is a part of a shell 41 which is rigid (see, e.g., column 3, line 64, to column 4, line 9 of BOURDEAU). Very differently in the invention, the frame is flexible.

Still further, in claim 1, as amended, Applicant specifies that the lateral arm extends from an upper end of the dorsal portion to one side of the boot.

At least for the foregoing reasons, Applicant submits that the combination of REINHART and BOURDEAU would not have been made by one skilled in the art except for the suggestion provided by Applicant's disclosure. Accordingly, reconsideration and withdrawal of the rejection based upon REINHART and BOURDEAU is requested.

**D. Withdrawal of Rejection Under 35 USC 103(a) Based Upon REINHART and BOURDEAU**

As mentioned above, claims 1-14, 16-18, 24-27, 29, and 30 are rejected under 35 USC 103(a) as being unpatentable over HOSHIZAKI in view of BOURDEAU.

Applicant's response to this rejection is similar to that above regarding the combination of REINHART and HOSHIZAKI. In this rejection, the Examiner again refers to the scallop 44 of BOURDEAU.

Although HOSHIZAKI is directed to a skate boot, rather than to a more general purpose shoe like that of REINHART, Applicant respectfully submits that one skilled in the art would not have made the modification suggested by the Examiner.

As explained above, BOURDEAU is directed to a sport boot having a sole and an attachment member (elements 31, 32) affixed to the sole against movement with respect to the sole. The boot comprises an upper having a rigid internal skeleton extending from a portion of the sole and upwardly at least along a lateral side of the boot. The skeleton constitutes a minimal energy circuit for the transmission of forces and support, such circuit passing through the attachment means of the boot.

For the boot of the invention, or with the boot of HOSHIZAKI, with no attachment means like that of BOURDEAU, there would have been no need to use the skeleton of ~~X~~ BOURDEAU. And with no skeleton, there would be no suggestion to one skilled in the art to make the dorsal part of the shoe of HOSHIZAKI higher in view of BOURDEAU.

Further, as explained above, regarding the wide scallop 44 of BOURDEAU, the same is a part of a shell 41 which is rigid, whereas, very differently in the invention, the frame is flexible.

Still further, in claims 13 and 14, Applicant calls for a flexible frame made of a substantially non-stretchable material and arranged to include at least a space between said dorsal portion and said outer sole.

At least for the foregoing reasons, Applicant submits that the combination of HOSHIZAKI and BOURDEAU would not have been made by one skilled in the art except for the suggestion provided by Applicant's disclosure. Accordingly, reconsideration and withdrawal of the rejection based upon HOSHIZAKI and BOURDEAU is requested.

#### **E. New Claims 31, 32**

New dependent claims 31 and 32 call for the flexible frame to not extend through a lower surface of the outer sole. Of course, portions 31 of the rigid frame of BOURDEAU extends

through the outer sole for the purpose of providing a connection to a snowboard.

**SUMMARY AND CONCLUSION**

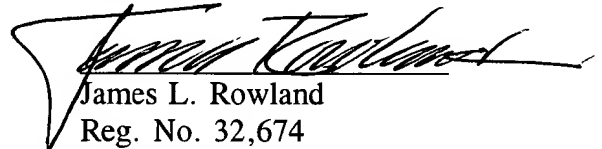
The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

Any amendment to the claims presented above, which has not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach to such amendments.

A check is attached for payment of claim fees and a fee for a three month extension of time. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
Marco CAERAN

  
James L. Rowland  
Reg. No. 32,674

October 7, 2002  
GREENBLUM & BERNSTEIN, P.L.C.  
1941 Roland Clarke Place  
Reston, VA 20191

(703) 716-1191 (telephone)  
(703) 716-1180 (fax)

**MARKED-UP VERSION OF AMENDMENTS****In the Claims**

Claims 1, 2, 13, and 14 are amended as follows:

1. (Three Times Amended) A sports boot, especially for gliding sports, comprising:

an outer sole and an external upper covering a user's foot and lower leg, the external upper comprising a flexible frame made of a flexible, substantially non-stretchable material, arranged along determinate directions of forces transmitted during use of the boot, said flexible frame being affixed to both the external upper and the outer sole, the flexible frame comprising a dorsal portion extending from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot, and at least one lateral arm laterally extending from [connecting] an upper end of the dorsal portion to one side of the boot.

2. (Amended) A sports boot comprising:

an outer sole and an external upper covering a user's foot and lower leg, the external upper comprising a flexible frame made of a flexible, substantially non-stretchable material, arranged along determinate directions of forces transmitted during use of the boot, said flexible frame being affixed to both the external upper and the outer sole, the flexible frame comprising a dorsal portion extending from the outer sole substantially up to a top end of the external upper, and at least one lateral arm laterally connecting the [the] dorsal portion to one side of the boot, said lateral arm spaced above the outer sole at the dorsal portion and extending forwardly from the dorsal portion and connected to the outer sole forwardly of the dorsal portion.

13. (Three Times Amended) A sports boot, especially for gliding sports, comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg, the external upper comprising a flexible frame made of a substantially non-stretchable material and affixed to the upper and sole, said flexible frame comprising a dorsal portion[,] extending vertically at the rear of the lower leg and including a space between said dorsal portion and said outer sole, [and] said flexible frame further comprising at least one lateral portion, extending laterally along the foot, connected to said dorsal portion and to the sole, at each of its ends, wherein the external upper extends above an ankle region to about a middle region of a tibia of the user.

Please amend claim 14 as follows:

14. (Three Times Amended) A sports boot, especially for gliding sports, comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg, the upper including a flexible frame made of a substantially non-stretchable material and arranged to include at least a space between said dorsal portion and said outer sole so as to provide a predetermined moment of inertia along predetermined directions, wherein the external upper extends above an ankle region to about a middle region of a tibia of the user.